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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,622	09/08/2000	James G. Gatto	08271.000009	3360

7590 01/10/2006

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EXAMINER
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FELTEN, DANIEL S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/658,622

Applicant(s)

GATTO, JAMES G.

Examiner

Daniel S. Felten

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 19-88 and 90-122 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-88 and 90-122 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. Receipt of the Request for Continued Examination ("RCE") filed October 20, 2005 is acknowledged. Claim 122 has been added. No amendment has been made of 19-88 and 90-121. Claims 19-88 and 90-122 are pending in the application and are presented to be examined upon their merits.

### ***Response to Arguments***

2. Applicant's arguments filed October 20, 2005 have been fully considered but they are not persuasive. It is apparent from applicant's response that a more stringent standard has been applied to the reference(s) than to the limitations of the claim(s). This is reversal of their appropriate roles, as the reference(s) is used as a whole as a teaching in light of the level of skill in the art. It is recognized that the examiner must give the claims their broadest reasonable interpretation consistent with the supporting description [see *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664 (Fed Cir. 2000)], however it is respectfully submitted that any interpretation of the claim language made by the examiner must be done in light of the specification *without* reading limitations into the claim [see *In re Morris*, 127, F.3d 1048, 1054-55 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997)]. In this case, the Examiner agrees with the applicant's observation that Morioka's display includes a number of detail levels; that there are a series of screens with groups of displays "based upon the input of the user... and the internal state of the process controller for each associative information; that there are "tabbed displays"; and that the system

Art Unit: 3624

displays the display information “group by group”. The Examiner disagrees with the applicant that Morioka does not display *on a single screen transaction information sufficient to enable the user to execute a transaction with a single selection from a single screen*. In the examiner’s interpretation of this limitation, there are several issues to consider or which makes Morioka read on this limitation:

***--There are really more than one screen claimed over all:***

There is a user-customized screen and a standard screen based upon if a user has stored transactions or transaction parameters. The examiner has interpreted “*...to display on a single screen...*” to also mean “*any*” screen that has transaction information. As has been noted previously, Morioka has at least one screen with transaction information where all input parameters are displayed in the screen of the display device (see col. 5, ll. 15-50). Moreover, all the information is provided on a display screen for the user’s perusal

***--There is a broad interpretation of “sufficient to enable” transaction information:***

The Examiner has interpreted “*...transaction information sufficient to enable a user to execute a transaction...*” to mean that there is a qualitative and/or quantitative (or both—not sure exactly what criteria is being used to establish this) aspect to the transaction information that “enables” a user to execute a transaction. There is nothing in the specification or the claims that provides an understanding of what the word “*sufficient*” would entail. Thus it is being interpreted by the Examiner that any user information provided directly or indirectly which in

Art Unit: 3624

turn allows the execution of any sort of financial transaction, as discussed previously being taught by Morioka (see col. 5, ll. 15-50), meets the claim limitation.

***--Intended use in the claim limitation:***

*The Examiner has interpreted "...transaction information sufficient to enable a user to execute a transaction..." as an intended use of the transaction information. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.*

The applicant has also broadly made the assertion that Morioka does not use previously stored transaction information in the manner claimed. It is assumed that the applicant is referring to ability of user information to be stored once and used for subsequent transactions. It is respectfully submitted that the applicant has not appreciated the level of ordinary skill in the art. It is notoriously old and well known that a database is merely a file composed of records each containing fields together with a set of records. It is also notoriously well known that the information in a file (or database) can be updated and used over and over. Morioka discloses that the CPU is connected to the host computer in the center via the terminal controller. The ATM communicates with the center and proceeds with the transaction while updating a book or *file* where the balance of each user and transaction log are stored (see col. 15, lines 2-10). Thus it is

Art Unit: 3624

respectfully submitted that there is personal information that being used by the CPU to recognize each users' personal file (or database) in order to update (or populate) fields in the file. Thus the previous rejections is maintained. A similar rejection is maintained below for claim 122.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 122 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morioka in view of Lawlor.

***Re claim 122***, An electronic transaction system for transactions relating to the purchase of goods, the system including: means for storing user-defined transaction parameters, where the transaction parameters can be stored once and used in connection with subsequent transactions; means for receiving user identification information; means for retrieving stored user-defined transaction parameters associated with the user identification information; means for enabling the user to perform one or more preliminary steps; a graphical user interface for facilitating the ability for a user to specify desired transaction parameters for a transaction, the graphical user interface including: means for simultaneously displaying on a single menu screen, the transaction parameters desired to define the transaction, including one or more of the user-defined transaction parameters associated with the user identification information; and means for enabling the user, from the single menu screen, to: i) make a single action to indicate the desire

Art Unit: 3624

to enter into a transaction using the transaction parameters displayed on the single menu screen, or ii) make one or more selections from the single menu screen to change one or more of the displayed transaction parameters and make a single action to indicate the desire to enter into a transaction with the changed transaction parameters displayed on the single menu screen (see previous action dated June 24, 2004 and Response to arguments above).



Art Unit: 3624

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Felten whose telephone number is (571) 272-6742.

The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel S Felten  
Examiner  
Art Unit 3624

DSF  
January 06, 2005